

# **REMARKS**

## **I. DRAWING**

The drawings were objected to under 37 C.F.R. 1.83 (a) for not showing every feature of the claimed apparatus. According to page 2 of the Office Action the multiple different thinning tools and their different features claimed in canceled claims 10 to 13 should be shown in the figures.

New claims 20 to 24 replace canceled claims 10 to 13 and do claim sets of different thinning tools. The features of new claims 20 to 24 are supported by page 3, line 15, to page 4, line 1, of the English translation of the originally filed specification and by canceled claims 10 to 13.

New sheets containing proposed figures 7a, 7b, and 7c accompany this amendment. The new figures 7a to 7c illustrate the features of the apparatus claimed in claims 20 to 24. Particularly they show the different embodiments of the thinning tools that differ in the number of tines 12 in the row 7 and the size of the tine slots 11.

Approval and entry of new figures 7a to 7c and withdrawal of the objection to the drawing under 35 CFR 1.83 (a) are respectfully requested.

## **II. ABSTRACT**

The original abstract was an abstract that was prepared in Europe to accompany the International Application and was not prepared in accordance with U.S. Patent Office Rules.

A new abstract that contains the subject matter of the new main independent claim 14 has been provided above, which is less than 150 words and otherwise complies with the US Rules for abstracts.

Withdrawal of the objection to the abstract under M.P.E.P. 608.01 (b) is respectfully requested in view of the new abstract.

### **III. SPECIFICATION CHANGES**

Changes have been made in the English translation of the specification, which was filed on April 29, 2008, to comply with US Patent Office recommendations and rules.

A Cross-reference to the International Application and the DE priority document has been added.

Standard section headings have been added, as recommended by US Patent Office Rules. Also references to claim 1 by number in the background section and summary section have been replaced by appropriate subject matter from canceled claim 1 and new claim 14.

The "Brief Description of the Drawing" section has been amended to include a brief description of the new figures 7a, 7b, and 7c.

The paragraphs on page 3, line 15, to page 4, line 1, in the English translation filed April 29, 2008 have been replaced with new paragraphs containing the same subject matter but including references to the new figures 7a, 7b, and 7c. No new matter has been added.

#### **IV. INDEFINITENESS REJECTION**

Claim 11 was rejected under 35 U.S.C. 112, second paragraph, for indefiniteness.

Claim 11 was rejected for stating that the set of thinning tools is provided with a width (B) that is “different but the same as each other”.

The new claims clearly claim the embodiments on pages 3 and 4 of the English translation of the specification.

For example, new claim 21 claims a set of thinning tools in which a first thinning tool has tine slots that are equal to each other and have a first width B and a further thinning tool that has tine slots that are equal to each other and have a second width B' that is different from the first width B. This corresponds to the disclosure on page 3, line 15, to page 3, line 20, of the English translation.

The new claim 23 claims a set of thinning tools in which a first thinning tool has tines with a spacing A that is different from the spacing A' of another thinning tool of the set. This corresponds to the disclosure on page 3, line 30, to page 4, line 1, of the English translation.

The new claim 24 claims a set of thinning tools in which the tine slots of the additional thinning tool (1) have widths (B'') and (B''') that are not equal to each other and that alternate in a direction from one side of the additional thinning tool to the other. This corresponds to the embodiment described on page 3, line 16 to page 3, line 29, of the English translation.

It is respectfully submitted that one skilled in the art would not be confused or in doubt regarding the scope of new claims 21 to 24.

## V. ANTICIPATION REJECTION

Claims 1, 10, 12, and 13 were rejected as anticipated under 35 U.S.C. 102 (b) by Fewins (US Patent 2,481,097).

Fewins does disclose a thinning tool 7, 8 for a clipper A comprising lower and upper shearing blades B, C (see fig. 1, 2 & 4 – 6). The thinning tool 7, 8 is embodied as placeable on the lower shearing blade B and does have a row of tines 9 with tine slots (unlabeled) between them. The tine slots will catch and guide hairs.

Fewins also discloses a second and third thinning tool with different thinning characteristics, as shown in figs. 3 and 7, which have different numbers of tines and different sized tine slots.

However the thinning tools of Fewins are different in their structure and features from the thinning tool of the new above claim 14.

They are not a solution to the problem that is solved by the applicants' novel thinning tool, which is described on page 1, lines 9 to 11, of the English translation of the applicants' specification. Applicants' thinning tool is designed so that the hairs gathered in each tine slot are cut one after the other in succession to provide a finer graduated thinning of the hair without a "strip-like" cut, which results from cutting more than one hair at a time in each tine slot (page 2, lines 15 to 20, of the English translation of the applicants' specification). The structure claimed in claim 14 is correspondingly different from the structure of the thinning tools of Fewins.

The applicants' claimed thinning tool according to claim 14 has:

- a) stops 17 (now claimed in claim 14) at the ends of the tines opposite their free ends, which abut against the free end 19 of the lower shearing blade 3, and act to properly position the bottoms of the tine slots at the tips of the shearing blades to accomplish the goal of cutting the hairs in each tine slot in succession one after the other as shown in applicants' fig. 5;
- b) the tines 12 of applicants' thinning tool are not an extension (L) of the teeth 5 of the lower shearing blade 13 (see applicants' fig. 5); and
- c) the tine slots have appropriate widths B, as defined in claim 14, so that hairs that are entrained in the bottom of each tine slot are cut one after the other, i.e. the widths of the tine slots are selected so that they are just large enough (again see fig. 5 – different thinning tools are designed for different types of hair, e.g. thin flaxen hair, thick black hair).

Fewins does **not** disclose a thinning tool 1 with the stops 17 at the bottom ends of their tines 9 that abut against the free end D of the lower shearing blade B. Figs. 4 to 6 of US '097 (Fewins) show that the embodiment described in Fewins has a lower shearing blade B that extends with its tips over the tines and the tine slots so that the thinning tool of Fewins underlies the blade B. For example, column 2, lines 34 to 45, state that:

“...hair guiding attachment [7,8] ....which embodies a plate portion 7 adapted to overlie the underside of the flat face F of the blade B from the forward edge of which plate [7] extends an upwardly inclined toothed plate portion 8 arranged to underlie the inclined undersides of teeth D and to conform thereto in close contact

therewith: the plate portion 8 being formed with a series of hair guiding or feed teeth [tines] 9 which protrude a short distance beyond the tips of the teeth D and E of the clipper."

Italics and underlining have been added for emphasis. This quote clearly shows that the tines of the prior art reference Fewins are arranged adjacent to the teeth of the lower shearing blade (fixed blade), and thus are not an extension (L) of the lower teeth, as claimed in new claim 14 and shown in fig. 5.

Furthermore there are no stops of any kind at the bottoms of the tines or teeth of the prior art tool, because the bottom ends of the tines of the prior art device do not abut on anything. The applicants' stops are protrusions that are not present on the prior art device (see applicants' fig. 4 and compare with fig. 1 of US '097).

The above-described structural differences facilitate the positioning of the bottoms of the tine slots at the tips of the shearing blades so that the hairs gathered in each tine slot can be cut in succession one at a time as shown in fig. 5.

Furthermore the width of the tine slots in Fewins is not limited to a size so that the hairs collected in each tine slot are basically cut in succession one after the other as shown in fig. 5. This produces an improved finely graduated thinning of the hair that is superior to the cut provided by the prior art thinning tools.

It is well established that each and every limitation of a claimed invention must be disclosed in a single prior art reference in order to be able to reject the

claimed invention under 35 U.S.C. 102 (b) based on the disclosures in the single prior art reference. See M.P.E.P. 2131 and also the opinion in *In re Bond*, 15 U.S.P.Q. 2nd 1566 (Fed. Cir. 1990).

Summarizing, the thinning tool of Fewins lacks the stops 17 that are present at the bottom ends of the tines or teeth of the thinning tool. Also the tines of Fewins are not an extension of the teeth of the lower shearing blade. Furthermore Fewins does not limit the widths of the tine slots to a size such that the hairs collected in each tine slot are cut in succession instead of simultaneously to produce a strip-like cut.

For the foregoing reasons it is respectfully submitted that new claims 14 to 24 should not be rejected under 35 U.S.C. 102 (b) as anticipated by Fewins (US Patent 2,481,097).

## VI. OBVIOUSNESS REJECTIONS

Claims 2 to 9 and 13 were rejected as obvious under 35 U.S.C. 103 (a) over Fewins (US Patent 2,481,097).

As applicants' read the passage at column 2, line 45, to column 3, line 2, of Fewins, there is no connection made between the "desired hair cutting characteristics" and the selected spacing of the teeth or tines of the thinning tool. The passage merely states that the tines or the thinning tool may be spaced any "suitable" distance apart without considering the spacing of the teeth of the shearing blades.

The reasoning on page 7 of the Office Action assumes that it is obvious to one skilled in the haircutting arts to select the various dimensions set forth in claims 2 to 9, especially the tine slot widths, to manipulate or adjust to obtain optimum results. However a case of *prima facie* obviousness under 35 U.S.C. 103 (a) can **only** be based on manipulating variables that are known or recognized in the prior art to be result-effective variables that can be adjusted to optimize a desired result according to M.P.E.P. 2144.05 II.

Fewins does not disclose the problem that the invention is designed to solve, i.e. that relatively wide tine slots will lead to a disadvantageously strip-like haircut or thinning of the hair. Thus Fewins does not recognize the benefits or advantages of reducing the widths of the tine slots, i.e. that a better finer cut is obtained. Fewins does not identify the width of the tine slots as the result-effective variable for eliminating the undesirable strip-like quality of the haircut produced using the prior art thinning tool.

If that were not enough Fewins teaches the opposite in column 4, lines 20 to 29, where he describes the advantages of increasing or enlarging the spacing between the tines, namely faster cutting of larger quantities of hair. It is well established that are references that teaches the opposite from a claimed invention should not be used to reject a claimed invention under 35 U.S.C. 103 (a). For example, the Federal Circuit Court of Appeals has said:

**“A reference should be considered as a whole, and portions arguing against or teaching away from the claimed invention must be considered.”**

***Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 230 U.S.P.Q. 416 (Fed. Cir. 1986)**

In addition, the structural differences between the thinning tool of Fewins and the thinning tool now claimed in claim 14 are not disclosed or suggested in Fewins or the prior art generally. These differences include the tine slot width described in functional terms in claim 14, the stops 17 of the thinning tool of claim 14 and the relationship between the teeth of the lower shearing blade and the tines of the tool according to claim 14.

New dependent claim 24 claims embodiments including an additional thinning tool, in which there are two different sized tine slots with widths B" and B''. Thus new dependent claim 24 replaces canceled claim 13.

The limitations and features of claim 24 are not relied on at this time to establish patentability hence separate arguments for allowance of claim 24 are not provided. New claim 24 should be allowed because claim 19, which includes the features and limitations of claim 14, should be allowed.

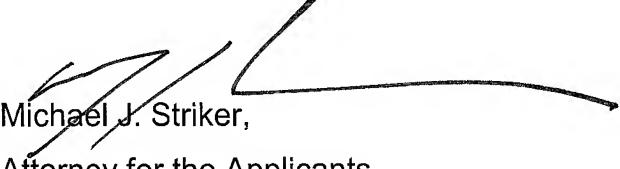
For the foregoing reasons it is respectfully submitted that new claims 14 to 24 should not be rejected under 35 U.S.C. 103 (a) over Fewins (US Patent 2,481,097).

Should the Examiner require or consider it advisable that the specification, claims and/or drawing be further amended or corrected in formal respects to put this case in condition for final allowance, then it is requested that such amendments or corrections be carried out by Examiner's Amendment and the

case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing the case to allowance, he or she is invited to telephone the undersigned at 1-631-549-4700.

In view of the foregoing, favorable allowance is respectfully solicited.

Respectfully submitted,



Michael J. Striker,  
Attorney for the Applicants

Reg. No. 27,233